

09/650,375

MS150957.01/MSFTP131US

REMARKS

Claims 1-67 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

**I. Rejection of Claims 1-11, 24-25, 27-36, 38-49, 51-57 and 59-66 Under 35 U.S.C §102(a)**

Claims 1-11, 24-25, 27-36, 38-49, 51-57 and 59-66 stand rejected under 35 U.S.C §102(a), as being anticipated by Ellis *et al* (WO 00/04709). This rejection should be withdrawn for at least the following reasons. Ellis *et al*. does not teach or suggest *each and every limitation* of the subject claims.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (*quoting Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Applicants' claimed invention relates to providing program criteria to facilitate programming of an associated system for recording a specific audio and/or visual program. Independent claims 1, 24, 30, 32, 40, 42, 44, 46, 51, and 59 recite similar limitations; namely *a server computer storing a plurality of tokens, each token having a system unique identifier for identifying a predetermined at least one of an audio and visual program; wherein the server is programmed to provide at least one token to a remote computer based on received selection criteria*. Ellis *et al*. does not teach or suggest such features of applicants' invention.

In particular, applicants' claimed invention provides for employment of a token that comprises information related to a media program, and the token can be transmitted (*e.g.*, downloaded by a user and sent *via* e-mail) to a recording device to facilitate automatic programming of the recording device to record the media program associated with the transmitted token. Accordingly, for example, a host computer of a media program can make available to a user (*e.g.*, employing e-mail) a token for transmitting to one or more recording devices; and the token can contain all necessary information to effect recording of the media by

09/650,375

MS150957.01/MSFTP131US

the recording device(s) that receive the token. Ellis *et al.* does not teach or suggest such novel aspects of applicants' claimed invention.

Rather, Ellis *et al.* relates to an interactive television program guide system with remote access. The system disclosed by Ellis *et al.* does not teach or suggest the use of a token having a unique identifier associated with at least one of an audio and visual program. Instead, the cited reference attempts to overcome conventional problems associated with having to remain proximate to a recording device in order to be able to utilize a programming guide to initiate recording of content on the recording device. In order to overcome this problem, Ellis *et al.* teaches a system that allows an individual to access remotely the programming guide, *e.g.*, via a remote program guide access device 24 connected to interactive television program guide equipment 17, to facilitate programming of the equipment 17 through the remote connection. See *e.g.*, Abstract, Fig. 1, pg. 3, line 32 – pg. 6, line 25.

Moreover, the cited reference discloses displaying of the programming guide to a user remotely so that the user can scan through available media and program the equipment from remote to record desired content. Thus, Ellis *et al.* teaches remote access to a program guide and recording equipment to facilitate programming of content thereof. Contrary, to assertions made in the Office Action, the cited reference does not teach or suggest the use of token(s) that have stored therein information to effect automatic programming of media associated with the token as in applicants' claimed invention.

A programming guide is not a token, one cannot simply transmit a programming guide to a recording device to effect programming thereof. Rather, a programming guide is an interactive table that provides for a user to view available content for recording and through coupling of the remote device, the programming guide and the interactive equipment, recording of desired content can be achieved. Ellis *et al.* does not provide for novel functionality as in applicants' claimed invention where a user can send a token to any one or more of a plurality of recording devices that will provide necessary information for the respective recording devices to initiate recording of media associated with the token. The cited reference is limited to remote access to a programming guide as well as recording equipment connected to the remote access device. On the other hand, through the use of tokens, applicants' invention provides for a decoupled framework to effect recording of content of interest.

It is readily apparent from at least the foregoing comments that Ellis *et al.* does not teach

09/650,375

MS150957.01/MSFTP131US

or suggest the use of tokens let alone in the novel manner of applicants' claimed invention. In view of at least the above, it is respectfully submitted that this rejection of the subject independent claims (as well as the claims that respectively depend there from) should be withdrawn.

**II. Rejection of Claims 15-21, 50, 58 and 67 Under 35 U.S.C §103(a)**

Claims 15-21, 50, 58 and 67 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Ellis *et al.* Withdrawal of this rejection is respectfully requested for at least the following reasons: The subject claims either directly (or indirectly *via* respective base claims) recite *the use of token(s) representing audio and/or video programs and transmitting such token(s)* in connection with effecting recording of the programs through use of the tokens... As noted *supra*, Ellis *et al.* does not teach or suggest the use of token let alone in the manner suggested by the subject claims; and this rejection should be withdrawn.

**III. Rejection of Claims 12-14, 22-23, 26 and 37 Under 35 U.S.C §103(a)**

Claims 12-14, 22-23, 26 and 37 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Ellis *et al.* in view of Knudson *et al.* (US 6,536,041). This rejection should be withdrawn for at least the following reasons. Ellis *et al.* and Knudson *et al.*, either alone or in combination, fail to teach or suggest all limitations set forth in applicants' claims.

The subject claims respectively depend from independent claims 1, 15, 24 and 32. As noted above regarding these independent claims, Ellis *et al.* does not teach or suggest *the use of unique identifying tokens for programming a recording system*; and Knudson *et al.* does not make up for such deficiencies of Ellis *et al.* - Knudson *et al.* simply relates to a program guide system that allows real-time data to be stored and updated in a database maintained on a user's program guide platform. Accordingly, it is respectfully submitted that the combination of these references do not make obvious applicants' invention as recited in the subject claims.

This rejection should be withdrawn.

09/650,375

MS150957.01/MSFTP131US

Conclusion


The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin  
Reg. No. 40,894

AMIN & TUROCY, LLP  
24<sup>TH</sup> Floor, National City Center  
1900 E. 9<sup>TH</sup> Street  
Cleveland, Ohio 44114  
Telephone (216) 696-8730  
Facsimile (216) 696-8731